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### REMARKS

This RCE Preliminary Amendment presents the above changes, and is further responsive in any manner indicated below.

### **REQUEST FOR EXAMINER INTERVIEW PRIOR TO FIRST ACTION AND NOTIFICATION OF INTENT TO FILE PRELIMINARY AMENDMENT**

An Examiner Interview prior to first Office Action in this continuing or substitute application is respectfully requested. As stated in MPEP §713.02, "A request for an interview prior to first Office Action is ordinarily granted in continuing or substitute applications." Similarly, as stated in MPEP §706.07(b), "A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted." After such Examiner Interview, Applicant intends to file a Supplemental Preliminary Amendment for adjusting/submitting claims which should be examined in the application. The Examiner is respectfully requested to telephone the attorney indicated on this paper at the local D.C. area number of 703-312-6600 to schedule an Examiner Interview. The Examiner is thanked in advance for such consideration. Contact also will be attempted by the undersigned attorney.

### PENDING CLAIMS

Claims 1-11 were pending, under consideration and subject to examination in the final Office Action in the original application. Appropriate ones of the claims have been amended in order to adjust a clarity and/or focus of Applicant's claimed invention, or merely for Idiomatic English and readability. That is, such changes are unrelated to any prior art or scope adjustment, and are simply refocused claims in

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which Applicant is presently interested. At entry of this paper, Claims 1-11 remain pending for further consideration and examination in this RCE application.

### REJECTIONS UNDER 35 USC §103 - PRECLUDED

All 35 USC §103 rejections of Claims 1-11 made in the original application as being unpatentable based upon combinations of Aloni *et al.* (US 6,360,005 B1), Steffan *et al.* (US 5,999,003 A), Nara *et al.* (US 6,421,122 B2) and Tanaka (US 5,995,087 A) are respectfully traversed. However, unrelated to any rejection or prior art, Claims 1-11 have now been amended to clarify Applicant's invention. Therefore, even though strong traversal of any of the rejections standing in the original application is appropriate, such rejections have been rendered wholly obsolete by the present clarifying amendments to Applicant's claims. Further, in order to preclude any renewal of such rejections, Applicant respectfully submits the following.

All descriptions of Applicant's disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed. As additional arguments, Applicant respectfully submits the following.

With regard to the requirements to support a rejection under 35 USC §103, reference is made to the decision *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a *prima facie* case of obviousness, and can satisfy this burden only by showing some

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objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the Court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability, and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination.

Applicant's claimed invention is not taught or suggested by any of the art cited in the original application.

More specifically, in the Advisory Action mailed 29 December 2003, the Examiner indicates in the "Response to Arguments" section (bottom of first page) that "Aloni clearly discloses a first area for displaying a plurality of detected images stored in a storage means (Col. 5, lines 46-48; Col. 15, lines 22-32)." Applicant respectfully STRONGLY TRAVERSES this error. Although there is a generic "display" mentioned in Aloni *et al.*, nowhere is there any mention of a first area of the display, let alone a plurality of second areas, nor any description of the display whatsoever other than a "CRT" (Col. 27, line 5). There is nothing whatsoever described about the operation of the generic display taught by Aloni *et al.*

The Examiner states, "Aloni discloses displaying defect images (Col. 15, lines 22-38), thereby allowing the user to see the actual image of the defect in order to classify each defect" (29 December 2003 Advisory Action, bottom of first page). Applicant respectfully STRONGLY TRAVERSES this error. Although Aloni *et al.* indicates at the column/lines cited by the Examiner that the display may be used for "defect classification," it does not indicate at all that it is used in order to classify

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each defect, or even that it is used to initially classify defects that are not classified. As is very explicitly stated at Col. 27, lines 5 *et seq.* in Aloni *et al.*, "an operator display 256 such as a CRT provides an on-line display for the operator of the defect analysis process" and that the information "comprises a display of the defect images analyzed by the false alarm reducing unit 250" and that such display only "enables the operator to review the defect images" and "to amend defect classifications" of the defects already analyzed and classified by the false alarm reducing unit 250 (see, Col. 27, line 40 through Col. 28, line 26).

The Examiner states that, "Aloni discloses interactive operations including defect elimination..., thereby providing a manual classification and more particularly, the claimed 'means for moving'" (29 December 2003 Advisory Action, sentence spanning bottom of first page and top of second page). Applicant respectfully STRONGLY TRAVERSES this error. Nowhere in Aloni *et al.* does it disclose or teach the claimed movement of an image on the display from a first area to a second area.

The Examiner states that, "As set forth in Aloni's column 15, lines 22-38, classification is completed after operator control operations. In other words, the user sees the defect image before it has been classified." (29 December 2003 Advisory Action, first two full sentences at the top of second page). Applicant respectfully STRONGLY TRAVERSES these errors. Again, Aloni *et al.* does not teach or suggest the claimed classification device or method. As discussed above, see, Col. 27, line 40 through Col. 28, line 26 of Aloni *et al.* specifically state that the operator may "amend" the classification from the information received from the false alarm

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reducing unit, which already has classified the error and is displaying the defect only because it needs confirmation that the defect is, indeed, a false alarm and not a defect (Col. 27, lines 12 *et seq.*). Further, although the column/lines relied upon by the Examiner indicates that a display allows an operator to "perform a variety of operator controlled operations such as defect detection system diagnostics, defect verification and elimination and defect classification," the "operator controlled operations" in Aloni *et al.* may very well be directed to operators such as the disclosed "DIFF" or "EROSION," since such labels are referred to after Col. 15 as "operators" and since the specific words "operator" and "user" are present in the same sentence (Col. 17, lines 34 *et seq.*). Therefore, in the system of Aloni *et al.*, an "operator" may not be human, and an "operator controlled operation" might refer to a software application function or a mechanical unit.

The Examiner states that, "As stated above, Aloni's first area is disclosed in column 5, lines 46-48. In general, different areas of a display could be considered as first and second areas. Steffan's teachings are cited for teaching specific areas in a screen. Steffan also teaches moving displayed information in an area to another area. Aloni explicitly discloses a first area and moving detected images (elimination operation, Col. 15, lines 22-32)" (29 December 2003 Advisory Action, lines 4 *et seq.* on second page). Applicant respectfully VERY STRONGLY TRAVERSES these errors. Again, as discussed hereinabove, there is no "first area" or any other information whatsoever disclosed regarding the set-up of the display of the analysis process in Aloni *et al.* Even assuming *arguendo* that in general different parts of a screen may be considered first and second areas, Aloni *et al.*

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**nor Steffan *et al.* nor Nara *et al.* nor Tanaka, nor any of the other cited art,  
either taken alone or in any combination, teach the claimed initial**

**classification system and method;** whether the "method of moving" used is  
block-cut-point-click or drag-and-drop makes no absolutely no difference, the  
claimed defect classification method and system are patentably distinct.

As a result of all of the foregoing, it is respectfully submitted that the applied  
art (taken alone and in the Office Action combinations) would not support either a  
§102 anticipation-type rejection or a §103 obviousness-type rejection of Applicant's  
clarified claims. Accordingly, such rejections are precluded, and express written  
allowance of all of the pending claims is respectfully requested.

#### REFERENCE ANTEDEATEABLE

Again, Applicant respectfully notes that the effective filing date (29 November  
1999) of the Nara *et al.* reference falls between the U.S. filing date (01 December  
1999) and the foreign priority date (01 December 1998) of the present application,  
and accordingly, such reference can be removed as valid prior art by the filing of an  
English language translation of Applicant's foreign priority application together with a  
statement that the translation of the certified copy is accurate. Applicant still  
respectfully reserves the right to file such certified English translation in order to  
remove such reference as valid prior art. The above statements, and/or the filing of  
any English translation, should not be taken as an indication or admission that the  
art is substantively relevant, but is merely use of a procedural approach to preclude  
art.

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### **SPECIFIC TRAVERSAL OF GRATUITOUS OFFICE ACTION COMMENTS**

Advisory Action comments in support of the art rejections assert that certain claimed features/limitations are present in the cited art, *i.e.*, without providing any supportive citation whatsoever for such assertions. With regard to such assertions, Applicant respectfully requests that the specific column and line in the references supporting the assertions that features are present be cited, or that such assertions be withdrawn as completely unsupported.

### **RESERVATION OF RIGHTS**

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer. That is, any above statements, or any present amendment or cancellation of claims (all made without prejudice or disclaimer), should not be taken as an indication or admission that any objection/rejection was valid, or as a disclaimer of any scope or subject matter. Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

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### EXAMINER INVITED TO CALL

The Examiner is invited to telephone the undersigned at the local D.C. area number of 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

### CONCLUSION

Applicant respectfully submits that the present application is now in condition for allowance, and an early Notice of Allowance to that effect is respectfully requested.

This Preliminary Amendment is being filed concurrently with a Request for Continued Examination (RCE) and a Petition for Extension of Time. To whatever other extent is actually appropriate and necessary, Applicant petitions for an extension of time under §1.136. Also submitted concurrently herewith is a Form PTO-2038 authorizing payment of all requisite fees. Please charge any actual required shortage in fees to ATS&K Deposit Account No. 01-2135 (Order No. 501.37892X00).

Respectfully submitted,



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Concurrent Submissions:  
Request for Continued Examination  
Petition for Extension of Time  
Form PTO-2038 (Fee Codes 1252/1801)